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| APPLICATION NO.  | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
|--|-------------|----------------------|---------------------|------------------|
| 09/923,704   | 08/07/2001  | Peter Malcolm        | 112634.120          | 2337             |
| 28089  | 7590        | 06/23/2005           | EXAMINER            |                  |
| WILMER CUTLER PICKERING HALE AND DORR LLP<br>399 PARK AVENUE<br>NEW YORK, NY 10022 |             |                      |                     | ELISCA, PIERRE E |
| ART UNIT   |             | PAPER NUMBER         |                     |                  |
|  |             | 3621                 |                     |                  |

DATE MAILED: 06/23/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

|                              |                  |                |
|------------------------------|------------------|----------------|
| <b>Office Action Summary</b> | Application No.  | Applicant(s)   |
|                              | 09/923,704       | MALCOLM, PETER |
|                              | Examiner         | Art Unit       |
|                              | Pierre E. Elisca | 3621           |

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

#### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### Status

1) Responsive to communication(s) filed on 11 April 2005.

2a) This action is FINAL.                    2b) This action is non-final.

3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### Disposition of Claims

4) Claim(s) 1-46,114-157,178-261,304-353,377-418,438-460 and 476-585 is/are pending in the application.

4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.

5) Claim(s) \_\_\_\_\_ is/are allowed.

6) Claim(s) 1-46,114-157,178-261,304-353,377-418,438-460 and 476-585 is/are rejected.

7) Claim(s) \_\_\_\_\_ is/are objected to.

8) Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

#### Application Papers

9) The specification is objected to by the Examiner.

10) The drawing(s) filed on \_\_\_\_\_ is/are: a) accepted or b) objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11) The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

#### Priority under 35 U.S.C. § 119

12) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a) All    b) Some \* c) None of:  
 1. Certified copies of the priority documents have been received.  
 2. Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.  
 3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

#### Attachment(s)

1) Notice of References Cited (PTO-892)                    4) Interview Summary (PTO-413)  
 2) Notice of Draftsperson's Patent Drawing Review (PTO-948)                    Paper No(s)/Mail Date. \_\_\_\_\_  
 3) Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
 Paper No(s)/Mail Date 41105.                    5) Notice of Informal Patent Application (PTO-152)  
 6) Other: \_\_\_\_\_

**DETAILED ACTION**

1. This office action is in response to Applicant's amendment, filed on 04/11/2005.
2. Claims 1-46, 114-157, 178-261, 304-353, 377-418, 438-460, and 476-585 are pending.
3. The rejection to claims 1-46, 114-157, 178-261, 304-353, 377-418, 438-460, and 476-585 under 35 USC 102 (b) as being anticipated by Shwed et al as set forth in the office action mailed on 01/06/2005 is maintained.

***Claim Rejections - 35 USC § 102***

4. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless -

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

5. Claims 1-46, 114-157, 178-261, 304-353, 377-418, 438-460, and 476-585 are rejected under 35 U.S.C. 102 (b) as being anticipated by Shwed et al (U.S. Pat. No. 5,835,726).

As per claims 10-46, 114-157, 178-261, 304-353, 377-418, 438-460, and 476-585 Shwed discloses a system/method for securing the flow of and selectively modifying

packets in a computer network by controlling the inbound and outbound, the system comprising:

A plurality of workstations adapted for connection to a computer network, each workstation having a memory (see., figs 1 and 2, abstract, col 3, lines 8-67, col 4, lines 1-44, col 9, lines 1-67, col 10, lines 1-67);

A data repository arranged to receive data from each of said workstations (see., abstract, col 3, lines 8-67, col 4, lines 1-44, col 9, lines 1-67, col 10, lines 1-67);

An application stored in said memory of each workstation for transmitting outbound data to said network and receiving inbound data from said network (see., figs 13 –15, abstract, col 3, lines 8-67, col 4, lines 1-44, col 9, lines 1-67, col 10, lines 1-67);

Policy data containing rules defining relevant commercial data which is to be stored in said data repository (see., col 3, lines 8-67, col 4, lines 1-44, col 9, lines 1-67, col 10, lines 1-67); and

An analyzer, said analyzer being operable in conjunction with said policy data to monitor at least one of said outbound data and said inbound data, to identify in at least one of said outbound data and said inbound data, relevant commercial data that is to be stored in said data repository in accordance with said rules in said policy data, and to cause said relevant commercial data to be stored in said data repository (see., abstract, col 3, lines 8-67, col 4, lines 1-44, col 9, lines 1-67, col 10, lines 1-67).

As per claim 2, Shwed discloses the claimed limitation wherein said relevant data that is to be stored in said data repository is encrypted prior to it being transmitted to said data repository (see., figs 13-15, col 11, lines 25-67, col 12, lines 1-67, col 13, lines 1-28).

As per claim 3, Shwed discloses the claimed limitation wherein said relevant data that is stored in said data repository is encrypted (see., figs 13-15, col 11, lines 25-67, col 12, lines 1-67, col 13, lines 1-28).

As per claim 4, Shwed discloses the claimed limitation wherein said computer network, to which said one or more workstations are adapted for connection, is the Internet (see., figs 1 and 2).

As per claim 9, Shwed discloses the claimed limitation wherein said analyzer is operable to identify, as relevant data, digital certificates contained in at least one of said outbound or said inbound data or used to digitally sign signed data in said inbound data or said outbound data, or sufficient descriptive data to identify such digital certificates, said digital certificates and/or said descriptive data being stored in said data repository (see., abstract, lines 21-30).

## RESPONSE TO ARGUMENTS

6. Applicant's arguments filed on 04/11/2005 have been fully considered but they are not persuasive.

REMARKS

7. In response to Applicant's arguments, Applicant argues that the prior art of record "Shwed" fails to disclose the recited feature:

a. "analyze inbound or outbound data from or to a workstation (filter module is interpreted as a workstation) to identify data". However, the Examiner respectfully disagrees with this assertion since Shwed discloses this limitation in col 3, lines 8-67, col 4, lines 1-44, col 9, lines 1-67, col 10, lines 1-67, specifically wherein said the security system of Shwed inspecting (inspecting or analyzing) and selectively modifying inbound and outbound data packets in a computer network....

b. "storage of digital certificates". As indicated above, Shwed discloses this limitation in the abstract, lines 21-30, specifically wherein said modification may include encryption, decryption, signature generation, signature verification. Please note that a signature generation or verification is readable as a digital certification, and the storage 212 can be utilized to keep reports as to the operation of the network and the success or failure of the security rules.

***Conclusion***

8. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not

mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Pierre E. Elisca whose telephone number is 703 305-3987. The examiner can normally be reached on 6:30 to 5:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, James Trammell can be reached on 703 305-9769. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



Pierre Eddy Elisca

**Primary Patent Examiner**

**June 14, 2005**